

Patent
Attorney Docket No.: AUS920010179US1
(IBM/0006)

REMARKS

Applicant thanks the Examiner for taking the time to conduct a telephone interview concerning the issues raised in the pending office action. The remarks below include those issues discussed during the telephone interview.

Claims 1-11 and 22-33 stand rejected under 35 U.S.C 101 because the claimed invention is directed to non-statutory subject matter. Applicant has amended independent claims 1, 22 and 32 to better describe the claimed invention as directed to statutory subject matter. Applicant respectfully requests reconsideration and withdrawal of the rejection of independent claims 1, 22 and 32 as well as for all claims depending therefrom.

Claims 1-33 stand rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent Application No. 2002/0083003 of Halliday, *et al.* Halliday discloses methods and apparatus that provides accurate time and usage based metering of client application or client application feature usage and the reporting of such usage on a public network. (Halliday, Abstract). Halliday discloses alternatives to traditional license granting systems for software use by a user on a client computer. (Halliday, ¶ 19). Halliday discloses a method and apparatus for real-time metering and retroactive billing for software application usage. (Halliday, ¶ 19).

Applicant claims computer implemented methods, systems and computer program products for execution by one or more processors that include, *inter alia*, transmitting e-content selected from e-books, e-videos, e-movies, e-documents, e-television and combinations thereof over a network to a computer to a computer, tracking one or more usage characteristics of an individual's access to the e-content, and accepting return of the e-content from the computer along with the one or more usage characteristics. (Claims 1, 12 and 22). Additionally, Applicant claims deleting the e-content from the client computing device. (Claim 32). Applicant's claims are not directed towards a replacement for licensing of software but are instead directed to e-books, e-videos, e-movies, e-documents, e-television and other similar items.

MPEP § 2131 provides:

"A claim is anticipated only if each and every element as set forth

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in the claim is found, either expressly or inherently described in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the . . . claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831 (Fed. Cir. 1990).

Applicant respectfully asserts that the amended claims are not anticipated by the cited prior art reference. Since Halliday discloses only downloading software that is executable on the client's computer, Halliday does not disclose downloading e-content for viewing, listening or combinations thereof, such as e-videos, e-television or e-books, which are limitations claimed by Applicant.

Furthermore, Halliday does not disclose accepting return of the e-content from the computer as claimed by Applicant in claims 1, 12 and 22 nor does Halliday disclose deleting the e-content from the client computing device as claimed by Applicant in claim 32. Halliday does not disclose that the application is either erased from the client computer or returned from the client computer. Halliday simply discloses that if the client does not have access to a valid license, the application is terminated. (Halliday, ¶ 13).

Therefore, because Halliday does not disclose each and every limitation claimed by Applicant in amended independent claims 1, 12, 22 and 32, Applicant respectfully requests reconsideration and withdrawal of the rejection of these independent claims as well as all claims depending therefrom.

Applicant respectfully asserts that all claims are now in condition for allowance and respectfully requests that a Notice of Allowance be issued. If the Examiner determines that a telephone conference would expedite the examination of this pending patent application, the Examiner is invited to call the undersigned attorney at the Examiner's convenience. In the event there are additional charges in connection with the filing of this Response, the Commissioner is hereby authorized to charge the Deposit Account No. 50-0714/IBM/0006 of the firm of the

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below-signed attorney in the amount of any necessary fee.

Respectfully submitted,
STREETS & STEELE



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